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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,232	07/02/2001	Uday W. Joshi	F-281	1871

919 7590 04/26/2006

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EXAMINER

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ART UNIT PAPER NUMBER

3661

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES**

Paper No. 041706

Application Number: 09/898,232
Filed: 07/02/2001
Appellants: Uday W. JOSHI et al.

MAILED

APR 26 2006

Brian A. Lemm
For Appellants

GROUP 3600

EXAMINER'S ANSWER

This is in response to appellants' brief on appeal filed on 02/09/2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

There is none related appeal and interference.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct. The pending claims for appeal are 1-7, 9, and 18-19.

(4) Status of Amendments After Final

There is no after-final rejection amendment.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is correct.

(7) Grouping of Claims

- Appellants' brief includes no statement about grouping of the pending claims in the brief.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

- Mori et al. (US Pat. 5,982,994)
- Fabel (US Pat.6,209,779)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The grounds for rejection (for pending claims 1-7, 9, and 18-19) are provided here for the convenience of both Appellants and the Board of Patent Appeals.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a), which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 5, 9 and 18-19 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994).

A. Per claims 1-2, and 18-19: Mori et al. suggest a method, and a system for generating a mailing using Internet, comprising:

- storing at a data center samples in a viewable format viewable for remote uses (i.e., remote CLIENTS 52, a HARD DISK 24, see Mori et al., Fig.1, ref 24);
- receiving a request for printing (e.g., an order from CLIENT 52, or a document/design for a mail piece – see Mori et al., Fig.27, Fig.18, refs. 523', 523, or Fig.25, ref. 559);
- converting said design to a viewable format (see Mori et al., col. 13 lines 6-12, and col. 21 lines 11-24), said viewable format being viewable from a remote computer (viewing by CLIENT 52) via a network (see Mori et al., Figs.1, 11);

- receiving an order for a plurality of pieces of said at least one mail piece from said remote computer via said network (COMMUNICATION PATH 53 – LAN/ETHERNET) see Mori et al., Fig.1, Fig.27, Fig. 44, Fig.18, ref. 523', or Fig.25, ref. 559);
- combining said order with another order to produce a single print run, then printing each sample (a first document, and a second document) on a paper (note that claim 1 does not require orders from different parties) see Mori et al., col. 18 lines 54-55 wherein Mori et al. suggest that 2 different samples/inputs can be printed upon selecting a “both-side printing” button);
- Mori et al. suggest about arranging those single print runs in a presort sequence – Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients (e.g., using address/location as a base-line for sorting).

Mori et al. do not disclose about physically mailing finished mail pieces.

However, it would have been obvious with one of ordinary skill in the art at the time of invention to recognize that Mori et al. distribute/sending printed jobs after finishing – e.g., mailing finished mail pieces (in the abstract, Mori uses a box for storing sorted mails, see also Mori et al., Fig.44) for the benefit of completing the required mailings because sending finished mail pieces are now more simpler, and easier from that presorting sequence step.

B. Per claim 5: Mori et al. suggest about receiving customized info. to print on a sample/mail piece, e.g., a font type (see Mori et al., col. 21 lines 34-52).

C. Per claim 9: Mori et al. suggest about receiving a design from a first business, and receiving another design by a different party (see Mori et al., Fig.1 for a network communication of different CLIENT 52 to a NETWORK PRINTER APPARATUS 20).

12. **Claims 3-4, 6-7, and 9 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994), in view of Fabel (US Pat. 6,209,779).**

A. Per claims 3-4: Mori et al. suggest of receiving contact information (this information may include receiver addresses, see Mori et al., these data are obvious in Fig.27 “INFORMATION NOTICE”).

Mori et al. do not expressly disclose that contact information is printed on a sample/a mail piece.

However, Fabel teaches that idea (e.g., including RETURN ADDRESS or ADDRESSEE ADDRESS, receiving respective contact information which is a recipient mailing list including names, wherein each name is printed on a mail piece - see Fabel, Fig.15).

It would have been obvious with one of ordinary skill in the art at the time of invention to combine Mori et al., and Fabel to disclose that contact information is printed on a sample/a mail piece for mailing to an addressee for an advantage of legibility.

B. Per claim 6: Mori et al. do not disclose a printed job on a postcard. However, Fabel teaches about printing on a post card having a first and second side (see Fabel, the abstract).

C. Per claim 7: Mori et al. suggest a step of printing on first side and second side of a sheet (see Mori et al., Fig.27 wherein the selected type of data is “BOTH-SIDE PRINTING”).

Mori et al. do not teach that a print job is a postcard printing job.

However, Fabel teaches that limitation (see Fabel, the abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine both Mori et al., and Fabel for printing on a postcard with 2 sides instead of a plain sheet because a postcard is made by a thicker sheet of paper. Mori et al.'s printer can be adjusted paper thickness to accept a thicker paper than regular papers for postcards as suggested by Fabel.

(13) Response to Argument:

At first, the examiner respectfully submits on page 4 of 21, section VII, the applicants are not correct when asserting that “the final rejection of claims 1-7, 9, 18, and 19 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability” is nonsense, and not true – the obvious rejections based on factual, and legal premise that support the position of unpatent-ability were clearly established (see Final Office Action mailed on Sept. 08, 2005, that final action was reviewed carefully on two different occasions with an SPE, and another primary examiner, one in Pre-Appeal Brief Review on 1/17/2006, and one in an Appeal Conference on 4/17/2006).

A. At least, the cited references of Mori et al. (US Pat.5,982,994), and Fabel (US Pat.6,209,779) read-on the claimed language, and the limitations of claims are suggested by those cited references.

A1. According to an argument on page 5, 3rd para. of the Appeal Brief, Mori et al. suggest about sorting/presorting before mailing; whether it is a presort or a sort after print-out, this sorting task was done before mailing to an address (within a printing job). Applicants disclose a reduction of mailing fee by presorting based on receiving addresses

“there exists a need for an economical and efficient method and system for mail piece production”, and “the aggregated mailing will have a lower postage cost per mail piece than each of the individual smaller mailings”; however, everyone would save mailing fees (“postal discounts”) by sending to a receiver fewer mails, this is very obvious.

A2. According to an argument on page 5, 4rd para. of the Appeal Brief, Mori et al. suggest about “a mail box 51”, this is clearly directed to mailed materials; and using “LAN interface driver 21b”. Applicants admit that there is an act of storing for printing jobs as in claim 1 “store the printed paper directly or indirectly from the printing information:” (see the Appeal Brief, page 6, para. 1st).

A3. The examiner is very surprised when the applicant does not recognize that Mori et al.’s patent suggest a user ability to select single-side or both side printing for a print job (see the Appeal Brief, page 3, lines 7-6); this is clearly disclosed in Mori et al., col.18 lines 54-55). The applicants MUST consider a cited patent as a whole, when the examiner indicates a clear ability of cited apparatus because such claimed functions are clearly taught by the cited reference(s).

A4. According to an argument on page 4, lines 9-10 of the Appeal Brief, Mori et al. suggest about “storing at a data center”, the examiner respectfully submits that it is very clear that in computer applications, within a storage device with many directories, a sub-directory can be made as “a data center”, and “a design” as claimed can be broadly considered as “an original document” (containing original format, font .etc, i.e., Postscript, or PCL (Printer Control Language, see Mori et al. col.13, lines 8-9)) – these read on claimed languages. Further, in the applicants’ specification, there is no requirement that a data center MUST be a discreet facility; in computer meanings, it can

merely be a separate storage location. Applicants also admit that there is an act of storing for printing jobs as in claim 1 “*store the printed paper directly or indirectly from the printing information:*” (see Appeal Brief, page 6, para. 1st) – in Mori et al., Fig.1 suggests a structure that although ref.20 may be referenced as a NETWORK PRINTER APPARATUS 20, it can also be detached as a discreet component, and can contain a “data center” stored in HARD DISK 24, PRINTING MECHANISM 23 can be a printer for a setting of SINGLE-PRINT RUN, and a MAIL BOX 51 can be sorted-outputs containers .

A5. The examiner respectfully submits that the amended claims are unpersuasive; although Mori et al.’s patent is not directed to generating a “physical” mailing (REMARKS of 12/06/2004, page 6 of 9, para.3), Mori et al. disclose a system, and a method that are capable of doing what the applicants claim (further after print out a hard copy, one of the purpose of that act is sending/ mailing that copy away from sorting out print jobs in specified orders) – please note that Mori et al. suggest of using a system to prepare a hardcopy for a mailing – the ONLY THING different in independent claim 1 is Mori et al. do not physically mail those hard copies away. The claimed subject matters are combining elements, printing on a single print run for each combination, and then sorting them before mailing away. Cited prior art already disclose those actions; therefore, these steps are not inventive.

A6. On page 6, para. 4 (of the 12/06/2004 REMARKS), the applicants argue “*There is no disclosure, teaching or suggestion in Mori et al. of storing a data center a design for each of a plurality of mail pieces as is recited in claim 1*”, the examiner disagrees (i.e., HARD DISK 24 (as a data center) can do above claimed function, see Mori et al., Fig.1).

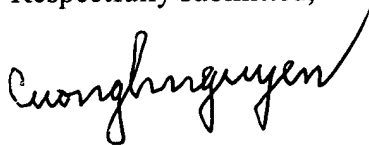
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A7. Again, the examiner submits that pending claims contain old and well-known method for generating a mailing by a network computer, and because of claiming obvious limitations taught by Mori et al., and Fabel, the examiner respectfully maintains the rejections.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Cuong H. Nguyen

April 17, 2006

An appeal conference was held on April 17, 2006 with:

SPE Thomas G. Black, AU 3661 

Pri. Exmr. Thomas Dixon, AU 3639 

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